

UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE BOARD OF PATENT APPEALS AND INTERFERENCES BOX INTERFERENCE, WASHINGTON, D.C. 20231

> Filed by: Fred E. McKelvey Telephone: (571) 272-9797 Facsimile: (571) 273-0042

MAILED

SEP 3 0 2005

PAT. & T.M. OFFICE BOARD OF PATENT APPEALS AND INTERFERENCES Applicants: Grubbs et al. Application No.: 09/576,370

Filed: 05/22/00

For: Imidazolidine-based metal carbene

metathesis catalysts

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,373.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

> Fred E. McKelvey Senior Administrative Patent Judge

INTERFERENCE DIGEST

Interference No. 105,373		Paper No.
Name: Robert H. Grubbs et al.		
Serial No.: 09/576,370	Patent No.	
Title: Imidazolidin-based metal carbene metathesis catalysts		
Filed: 05/22/00		
Interference with Nolan et al.		
DECISION ON MOTIONS		
Administrative Patent Judge,	Dated,	
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FINAL DECISION		
Board of Patent Appeals and Interferences,	_Dated,	
Court,	Dated,	
REMARKS		

This should be placed in each application or patent involved in interference in addition to the interference letters.

Paper 1

Mail Stop Interference P.O. Box 1450 Alexandria Va 22313-1450

Filed 30 September 2005

Tel: 571-272-9797 Fax: 571-273-0042

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

(Senior Administrative Patent Judge McKelvey)

ROBERT H. GRUBBS and MATTHIAS SCHOLL,

Junior Party (Application 09/576,370),

v.

STEVEN P. NOLAN and JINKUN HUANG

Senior Party (Application 09/392,869).

MAILED

SEP 3 0 2005

PAT. & T.M. OFFICE BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 105,373 Technology Center 1600

DECLARATION - Bd.R. 203(d)

Before McKelvey, Senior Administrative Patent Judge. 1

Part A. Declaration of interference

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties. Details of the applications, count and claims designated as corresponding or as not corresponding to the counts appear in Parts E and F of this DECLARATION.

As part of Board efforts under the Government Paperwork Elimination Act, signatures on papers originating from the Board are being phased out in favor of a completely electronic record. Consequently, in this case papers originating at the Board will not have signatures. The signature requirements for the parties have not changed. See, e.g., 37 C.F.R. § 10.18.

Part B. Judge managing the interference

Administrative Patent Judge McKelvey has been designated to manage the interference. 37 CFR § 41.104(a) [Bd. R. 104(a)].

Part C. Standing order

A Trial Section STANDING ORDER (Paper 2) accompanies this DECLARATION. The STANDING ORDER applies to this interference.

Part D. Initial conference call

A telephone conference call to discuss the interference is set for 1:30 p.m. (1330 hours) on Wednesday, 30 November 2005 (the Board will initiate the call).

No later than **two business days (i.e., Monday, 28 November 2005)** prior to the conference call, each party shall file and serve by facsimile (STANDING ORDER ¶ 4.5) a list of the motions (Bd. R. 120; Bd. R. 204; STANDING ORDER ¶ 26) the party intends to file.

A sample schedule for taking action during the motion phase appears as Form 2 in the STANDING ORDER. Counsel are encouraged to discuss the schedule prior to the conference call and to agree on dates for taking action. A typical motion period lasts approximately eight (8) months. Counsel should be prepared to justify any request for a shorter or longer period.

Part E. Identification and order of the parties

Junior Party

Named inventors: Robert H. Grubbs, South Pasadena, CA

Matthias Scholl, Pasadena, CA

Application: Application 09/576,370,

filed 22 May 2000

Imidazolidine-based metal carbene Title:

metathesis catalysts

California Institute of Technology Assignee:

Provisional application 60/142,853, filed 07 July 1999² Accorded Benefit:

 $^{^2\,}$ It is noted that Grubbs claims priority of provisional application 60/135,493, filed 24 May 1999. To the extent Grubbs believes it is entitled to benefit for the purpose of priority of the provisional application, a motion for benefit may be listed in the motions list.

Senior Party

Named Inventors: St

Steven P. Nolan, New Orleans, LA

Jinkun Huang, New Orleans, La

Application:

09/392,869

filed 09 September 1999

Title:

Catalyst complex with carbene ligand

Assignee:

University of New Orleans Foundation

Accorded Benefit:

Provisional application 60/115,358,

filed 08 January 1999

None³

 $^{^3}$ It is noted that Nolan claims priority of provisional application 60/099,722 filed 10 September 1998. To the extent Nolan believes it is entitled to benefit for the purpose of priority of the provisional application, a motion for benefit may be listed in the motions list.

The senior party is assigned exhibit numbers 1001-1999. Bd. R. 154(c)(1).

The junior party is assigned exhibit numbers 2001-2999.

Bd. R. 154(c)(1).

The senior party is responsible for initiating settlement discussions. STANDING ORDER \P 18.

Part F. Counts and claims of the parties

Count 1

A composition of matter having the formula:

where:

M is osmium (Os) or ruthenium (Ru);

P is phosphorous

R₁ is hydrogen (-H), hydrocarbyl or substituted
hydrocarbyl;

R₂ is hydrogen (-H), hydrocarbyl or substituted
hydrocarbyl;

R₃ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;

R₄ is hydrogen (-H), hydrocarbyl or substituted
hydrocarbyl;

 R_{s} is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;

R₆ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl;

R₇ is hydrogen (-H), hydrocarbyl or substituted hydrocarbyl but cannot be -C=C-YZ, where Y and Z are any moiety;

R₉ is alkyl having 1 to 10 carbon atoms or aryl having 5
to 20 carbon atoms;

R₁₀ is alkyl having 1 to 10 carbon atoms or aryl having 5 to 20 carbon atoms;

R₁₁ is alkyl having 1 to 10 carbon atoms or aryl having 5
to 20 carbon atoms;

 X_1 is an anionic ligand; and

 X_2 is an anionic ligand.

NOTE: There is no R_8 .

The claims of the parties are:

Grubbs: 1-64

Nolan: 9, 11-14, 17-21, 23-40, 43-65, 71-73 and

77-111

The claims of the parties which correspond to Count 1 are:

Grubbs: 1-39 and 41-64

Nolan: 9, 11-14, 17-21, 23-40, 45-46, 51-62, 71, 73,

77-78, 89-92 and 107-109

The claims of the parties which do <u>not</u> correspond to Count 1 are:

Grubbs: 40

Nolan: 43-44, 47-50, 63-65, 72, 79-88, 93-106 and

110-111

Part G. Heading to be used on papers

The heading in STANDING ORDER Form 1 must be used on all papers filed in this interference. See STANDING ORDER \P 7.2.1. The administrative patent judge and parties must be indicated as follows:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Senior Administrative Patent Judge McKelvey)

ROBERT H. GRUBBS and MATTHIAS SCHOLL,

Junior Party (Application 09/576,370),

v.

STEVEN P. NOLAN and JINKUN HUANG,

Senior Party (Application 09/392,869).

Patent Interference No. 105,373 Technology Center 1600

Part H. Order form for requesting file copies

When requesting copies of files, use of STANDING ORDER Form 4 will greatly expedite processing of the request. Please attach a copy of Part E of this DECLARATION with a hand-drawn circle around the patents and applications for which a copy of a file wrapper is requested.

Part I. Required paragraph for affidavits and declarations

The Board has recently experienced a rash of cases in which a witness has belatedly advanced reasons why he or she would be unable to appear for cross examination at a reasonable time and place in the United States. Consequently, the Board is requiring the following paragraph to be included on the signature page of all affidavits (including declarations) filed in this case to prevent surprise and hardship to the party relying on the testimony of the witness:

In signing this affidavit/declaration, I recognize that the affidavit/declaration will be filed as evidence in a contested case before the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office. I also recognize that I may be subject to cross examination in the case and that cross examination will take place within the United States. If cross examination is required of me, I will appear for cross examination within the United States during the time allotted for cross examination.

Enc (there is no Form PTO-850):

STANDING ORDER (Paper 2) Claims Nolan application 09/392,869 Bibliographic data Nolan application 09/392,869 Power of attorney application 09/392,869 Specification, as filed for Nolan application 09/392,869 Nolan provisional application 60/099,722 Original claims application 09/392,869 Nolan provisional application 60/115,358 Grubbs provisional application 60/142,835 Grubbs specification application 09/576,370 Grubbs original claims application 09/576,370 Grubbs drawings application 09/576,370 Amendment adding claim application 10/576,370 Stevens, "Polymer Chemistry," pages 285-289 (1990) Collman, "Principles and Applications of Organotransition Metal Chemistry, pages 591-592

Revised January 2005

cc (via overnight delivery):

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Email: None

Attorney for the United States [28 CFR § 0.45(f)]:

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